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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,438	03/29/2001	J. Guy Breitenbucher	ORT-1396	5665
27777	7590	03/25/2004	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			LIU, HONG	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/820,438		BREITENBUCHER ET AL.	
	Examiner		Art Unit	
	Hong Liu		1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18,20-22,33 and 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,8-16,20-22,33 and 34 is/are rejected.
- 7) ☒ Claim(s) 3-7,17 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-18, 20-22, 33, and 34 are pending in this application.

This action is in response to the applicants' amendment and reply filed on December 22, 2003.

Response to Arguments

Applicants' arguments and amendments filed on December 22, 2003 have been fully considered but they are not persuasive. Rejections of Claims under 35 U.S.C. § 112, second paragraph, and 103(a) are maintained.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

The rejection of claims under 35 U.S.C., 112, second paragraph, is hereby withdrawn in view of applicant's arguments.

Claim Rejections - 35 USC § 102

The rejection of claims under 35 U.S.C., 112, second paragraph, is hereby withdrawn in view of applicant's amendments.

Claims 1,2, 10, 11, 14, 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Plantier et al., Chem Abstract CA64:1906b. The instantly claimed compounds read on the reference compound, see the enclosed copy of CAPLUS

computer search report and the compound having RN 6829-35-2, i.e., R1 and R3 are H, Z is NR13R14.

Claim Rejections - 35 USC § 103

Claims 1, 2, 8-16, 20, 21 remain rejected and claims 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neuenschwander et al. Applicants' arguments have been fully considered but they are not persuasive. Applicants argue that the instant claimed compounds have different utilities from the reference compounds and none of applicant' compounds is specifically disclosed in the reference. While it is true that the compounds have different utilities, the instant claims are all directed to compounds not utilities, i.e., methods of use. Although the Neuenschwander reference lacks specific examples of compounds, the generic teaching of the reference embraces the instantly claimed compounds. By disclosing that A can be imidazole, piperidine, piperazine, etc., the reference suggests that changing A from a bridged bicyclic ring to an imidazole, piperidine, piperazine would provide the same results for the biological activities of the compounds, namely their use as squalene synthase inhibitors. Thus, it would have been obvious to one skilled in the art at the time of the invention to modify any of the species of the genus taught by the reference including those instantly claimed, because the skilled chemist would have the reasonable expectation that the known compounds in the reference would retain their activity.

The rejection of claims over the Connor reference (WO 98/06703) is hereby withdrawn in view of applicant's amendments.

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Examiner Hong Liu whose telephone number is (571) 272-0669. The examiner can normally be reached on Monday through Friday from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by the phone are unsuccessful, the examiner's supervisors, Mukund Shah can be reached at (571) 272-0674. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 1624

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 358-1235.



Mukund Shah
Supervisory Patent Examiner
Art Unit 1624

hl
March 10, 2004